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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,547	02/21/2002	Heinrich Gers-Barlag	Beiersdorf 571.2-HCL	6349

7590 11/14/2003

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EXAMINER

HARTLEY, MICHAEL G

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 11/14/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/081,547	<b>Applicant(s)</b> GERS-BARLAG ET AL.	
	<b>Examiner</b> Michael G. Hartley	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☒ Certified copies of the priority documents have been received in Application No. 09/367,365.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other:  |

Art Unit: 1616

### ***Response to Amendment***

The preliminary amendment filed 2/21/2002 has been entered. Claims 1-12 have been canceled.

New claims 13-24 have been added.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 19 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 7 of prior U.S. Patent No. 6,379,680. This is a double patenting rejection.

The pending claim is limited to the same embodiment of claim 7 in the US patent. There is no additional scope in either claim. Thus, the claims cover the same subject matter.

Claim 23 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 9 of prior U.S. Patent No. 6,558,683. This is a double patenting rejection.

The pending claim is limited to the same embodiment of claim 9 in the US patent. The same exact method steps are recited, as are the same exact components used therein. A non-distinguishing difference is the "for preparing..." limitation as pending claim 23 depends on claim 13, which states "water-in-oil" emulsion, while the patent claims depends on a claim which states "oil-in-water" emulsion. However, this difference is non-distinguishing because both the methods steps and the components used therein are the same, with no difference.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759

Art Unit: 1616

F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,379,680. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 is generic to all that is recited in claim 1 of the patent. That is, claim 13 falls entirely within the scope of claim 1 of the patent, or in other words, claim 13 is anticipated by claim 1 of the patent. Claim 1 of the patent limits the coating on the surface of the metal oxide, while claim 13 is generic to the particles but has the same properties as afforded thereby (and such coatings are in dependent claims). For example, the pigment particles defined by claim 1 of the patent are within the scope of the generic claimed pigment particles claimed. No other notable differences are seen.

Claims 13-22 and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,582,707. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 is generic to all that is recited in claim 1 of the patent. That is, claim 13 falls entirely within the scope of claim 1 of the patent, or in other words, claim 13 is anticipated by claim 1 of the patent. Claim 1 of the patent limits the coating on the surface of the metal oxide, while claim 13 is generic to the particles but has the same properties as afforded thereby (and such coatings are in dependent claims). For example, the pigment particles defined by claim 1 of the patent are within the scope of the generic claimed pigment particles claimed. Another difference is the patented claims recite both, water-in-oil or oil-in-water emulsions, while the instant claims are limited to one embodiment, water-in-oil emulsions.

Claims 13-22 and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,585,983. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 is

Art Unit: 1616

generic to all that is recited in claim 1 of the patent. That is, claim 13 falls entirely within the scope of claim 1 of the patent, or in other words, claim 13 is anticipated by claim 1 of the patent. Claim 1 of the patent limits the coating on the surface of the metal oxide, while claim 13 is generic to the particles but has the same properties as afforded thereby (and such coatings are in dependent claims). For example, the pigment particles defined by claim 1 of the patent are within the scope of the generic claimed pigment particles claimed. Another difference is the patented claims require an electrolyte, while the instant claims are generic thereto, by optionally having auxiliaries, additives and/or active ingredients, which are defined by the specification to encompass electrolytes.

Claims 13-22 and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,579,529. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 is generic to all that is recited in claim 1 of the patent. That is, claim 13 falls entirely within the scope of claim 1 of the patent, or in other words, claim 13 is anticipated by claim 1 of the patent. Claim 1 of the patent limits the coating on the surface of the metal oxide, while claim 13 is generic to the particles but has the same properties as afforded thereby (and such coatings are in dependent claims). For example, the pigment particles defined by claim 1 of the patent are within the scope of the generic claimed pigment particles claimed. Another difference is that the patented claims recite both, water-in-oil or oil-in-water emulsions, while the instant claims are limited to one embodiment, water-in-oil emulsions. The patented claims also recite "Pickering emulsions" in the preamble; however, the specification defines the emulsions to be Pickering emulsions, e.g., pages 10, 11, 13 and 14. Also, since the same components may be present in the claimed and patented emulsions, the term "Pickering" in the preamble of the patent claims does not differentiate.

Claims 13-22 and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,410,035. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 is generic to all that is recited in claim 1 of the patent. That is, claim 13 falls entirely within the scope of claim 1 of the patent, or in other words, claim 13 is anticipated by claim 1 of the patent. Claim 1 of the

Art Unit: 1616

patent limits the coating on the surface of the metal oxide, while claim 13 is generic to the particles but has the same properties as afforded thereby (and such coatings are in dependent claims). For example, the pigment particles defined by claim 1 of the patent are within the scope of the generic claimed pigment particles claimed. Another difference is the patented claims require at least one polymeric moisturizer, while the instant claims are generic thereto, by optionally having auxiliaries, additives and/or active ingredients, which are defined by the specification to encompass such moisturizers.

Claims 13-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,391,321. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 is generic to all that is recited in claim 1 of the patent. That is, claim 13 falls entirely within the scope of claim 1 of the patent, or in other words, claim 13 is anticipated by claim 1 of the patent. Claim 1 of the patent limits the coating on the surface of the metal oxide, while claim 13 is generic to the particles but has the same properties as afforded thereby (and such coatings are in dependent claims). For example, the pigment particles defined by claim 1 of the patent are within the scope of the generic claimed pigment particles claimed. Another difference is the patented claims specify components present in the oil-phase, while the claims are generic thereto and only require an oil-phase. The oil phase in the patented claims is encompassed by the generic oil phase claimed.

Claims 13-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-30 of copending Application No. 10/081,618. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 is generic to all that is recited in claim 14 of the copending application. That is, claim 13 falls entirely within the scope of claim 14 of the copending application, or in other words, claim 13 is anticipated thereby. For example, the claims of the co-pending application '168 require at least one polymeric moisturizer, while the instant claims are generic thereto, by optionally having auxiliaries, additives and/or active ingredients, which are defined by the specification to encompass such moisturizers.

Art Unit: 1616

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 13-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-26 of copending Application No. 10/081,613. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 is generic to all that is recited in claim 14 of the copending application. That is, claim 13 falls entirely within the scope of claim 14 of the copending application, or in other words, claim 13 is anticipated thereby. The copending claims also recite "Pickering emulsions" in the preamble; however, the specification defines the emulsions to be Pickering emulsions, e.g., pages 10, 11, 13 and 14. Also, since the same components may be present in the claimed and copending emulsions, the term "Pickering" in the preamble of the copending claims does not differentiate.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

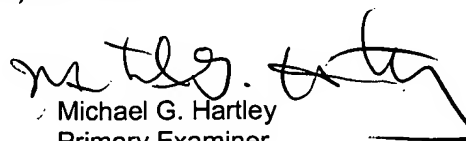
### **Conclusion**

No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Hartley whose telephone number is (703) 308-4411. The examiner can normally be reached on M-F, 7:30-5, off alternative Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
Michael G. Hartley  
Primary Examiner  
Art Unit 1616

MH